

REMARKS

Claims 1-33 are pending in the present application. Claims 1 and 28 have been amended. No new matter has been added.

Claims 1-9, 13-18, 23-33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,332,134 to Foster (“Foster”) in view of U.S. Patent Publication No. 2002/0016769 to Barbara et al. (“Barbara”). Claims 10-12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Foster in view of Barbara, and further in view of “Creating a Payment System Network: The Tie That Binds or an Honorable Peace?,” David A. Balto (“Balto”). Claims 19-22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Foster in view of Barbara, and further in view of “Behind the Spree in Payments for C2C,” Cathy Bowen (“Bowen”).

Rejection of Claims 1-9, 13-18, 23-33 under 35 U.S.C. § 103(a)

Claims 1-9, 13-18, 23-33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,332,134 to Foster (“Foster”) in view of U.S. Patent Publication No. 2002/0016769 to Barbara et al. (“Barbara”). The rejection is respectfully traversed and reconsideration is requested. Foster and Barbara, alone or in combination, do not teach or suggest each and every element of the pending claims in at least the following respects:

Foster and Barbara fail to teach or suggest “and if the first party does not have an account with the third party, by establishing an account for use in at least the electronic transaction,” as recited in pending claims 1 and 28. Amended claims 1 and 28 recite “and” rather than “or” and are believed to now overcome the examiner’s rejection.

Foster recites a system where a first party (*e.g.*, a cardholder) only has an account with a third party (*e.g.*, a card company), but does not teach or suggest establishing a new account after the payment instructions. “[A] cardholder makes a purchase from a merchant using credit *established* at a financial institution.” Col. 2, line 67 to col. 3, line 2 (emphasis added). Thus, in Foster, the credit must already be established, *i.e.*, a credit card account must already exist. In fact, Foster only refers to the first party as a “cardholder” because the party must already have a credit card with the third party.

In contrast, according to claims 1 and 28, a first party (*e.g.*, a consumer) can establish a new account with a third party (*e.g.*, a bank) if the first party does not already have an account with the third party. Unlike the Foster, the new account can be established with the third party *after* “receiving payment instructions electronically from the first party by a third party.”

Moreover, claims 1 and 28 recite “wherein satisfying the obligation further comprises placing a payment in satisfaction of the obligation in a holding account solely for retrieval via an automated teller machine (ATM) by the second party.” The examiner admits Foster fails to teach or suggest the second party receiving payment via an automated teller machine. Barbara fails to cure the deficiencies of Foster.

Barbara fails to teach or suggest “wherein satisfying the obligation further comprises placing a payment in satisfaction of the obligation in a holding account solely for retrieval via an automated teller machine (ATM) by the second party,” as recited in claims 1 and 28. The examiner asserts that the “transaction account 30” could be a holding account, but Barbara does not teach or suggest a holding account for the purpose of retrieval by the second party via an ATM. Instead, Barbara recites a “transaction account 30” that is provided for a bank customer with a bank account number and an associated ATM card and that is a “depository account subject to all of the rules and regulations of any bank account” and with many typical bank account features plus additional features. *See, e.g.*, para. [0059]. Barbara clearly establishes that the “transaction account 30” does not teach or suggest a holding account for the purpose of retrieval by the second party via an ATM and in fact teaches away from the recited claim language.

Consequently, the claimed combinations recited in independent claims 1 and 28 are not taught or suggested by Foster and Barbara, separately or in combination with one another. Because the cited references, either alone or in combination, do not teach or even suggest the limitations of independent claims 1 and 28, the examiner has failed to establish the required *prima facie* case of unpatentability. *See In re Royka*, 490 F.2d 981, 985 (CCPA 1974) (holding that a *prima facie* case of obviousness requires the references to teach all of the limitations of the rejected claim); *see also* MPEP § 2143.03. Similarly, the examiner has failed to establish a *prima facie* case of unpatentability for claims 2-9, 13-18, and 23-27 depending on claim 1 and

claims 29-33 depending on claim 28 and which recite further specific elements that have no reasonable correspondence to the references. Accordingly, the undersigned representative respectfully requests that the examiner withdraw the rejection of claims 1-9, 13-18, and 23-33.

Rejection of Claims 10-12 under 35 U.S.C. § 103(a)

Claims 10-12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Foster in view of Barbara as applied to claim 9 above, and further in view of “Creating a Payment System Network: The Tie That Binds or an Honorable Peace?,” David A. Balto (“Balto”). The rejection is respectfully traversed and reconsideration is requested. As noted above, Foster and Barbara fail to teach or suggest the required combinations of independent claim 1 on which claims 10-12 depend. The proposed modification of Foster in view of Balto, which recites collusion issues in connection with VISA interchange fees, lacks one or more limitations recited in independent claim 1, and there is inadequate articulated reasoning with rational underpinning to support the Examiner’s legal conclusion of obviousness.

Consequently, the claimed combinations recited in independent claim 1 are not taught or suggested by Foster, Barbara, and Balto, either separately or in combination with one another. Because the cited references, either alone or in combination, do not teach the limitations of independent claim 1, the examiner has failed to establish the required *prima facie* case of unpatentability. *See In re Royka*, 490 F.2d 981, 985 (CCPA 1974) (holding that a *prima facie* case of obviousness requires the references to teach all of the limitations of the rejected claim); *see also* MPEP § 2143.03. Similarly, the examiner has failed to establish a *prima facie* case of unpatentability for claims 10-12 depending on claim 1 and which recite further specific elements that have no reasonable correspondence to the references. Accordingly, the undersigned representative respectfully requests that the examiner withdraw the rejection of claims 10-12.

Rejection of Claims 19-22 under 35 U.S.C. § 103(a)

Claims 19-22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Foster in view of Barbara as applied to claim 1 above, and further in view of “Behind the Spree in Payments for C2C,” Cathy Bowen (“Bowen”). The rejection is respectfully traversed and reconsideration is requested. As noted above, Foster and Barbara, alone or in combination, fail

to teach or even suggest the required combinations of independent claim 1 on which claims 19-22 depend. The proposed modification of Foster in view of Bowen, which discusses insurance and escrows, lacks one or more limitations recited in independent claim 1, and there is inadequate articulated reasoning with rational underpinning to support the examiner's legal conclusion of obviousness.

Consequently, the claimed combinations recited in independent claim 1 on which claims 19-22 depend are not taught or suggested by Foster, Barbara, and Bowen, either alone or in combination with one another. Because the cited references, either alone or in combination, do not teach the limitations of independent claim 1, the examiner has failed to establish the required *prima facie* case of unpatentability. *See In re Royka*, 490 F.2d 981, 985 (CCPA 1974) (holding that a *prima facie* case of obviousness requires the references to teach all of the limitations of the rejected claim); *see also* MPEP § 2143.03. Similarly, the examiner has failed to establish a *prima facie* case of unpatentability for claims 19-22 depending on claim 1 and which recite further specific elements that have no reasonable correspondence to the references. Accordingly, the undersigned representative respectfully requests that the Examiner withdraw the rejection of claims 19-22.

CONCLUSION

The undersigned representative respectfully submits that this application is in condition for allowance, and such disposition is earnestly solicited. If the Examiner believes that the prosecution might be advanced by discussing the application with the undersigned representative, in person or over the telephone, we welcome the opportunity to do so. In addition, if any additional fees are required in connection with the filing of this response, the Commissioner is hereby authorized to charge the same to Deposit Account 50-4402.

Respectfully submitted,

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